

REMARKS

I. Amendments

By this amendment, claims 13 and 16 have been amended and claims 14, 15 and 18 have been cancelled.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

No change of inventorship is necessitated by this amendment.

II. Consideration of a Previously Submitted Information Disclosure Statement

An Information Disclosure Statement to disclose six references was filed on April 16, 2001. Applicants respectfully request consideration of the IDS and entry into the record. If the Information Disclosure Statement is missing from the Examiner's file the Examiner is respectfully requested to contact Applicants' attorney for a copy.

III. Discussion of the Rejection of Claim 18 under 35 U.S.C. Sec. 112, First Paragraph

Claim 18 has been rejected under 35 U.S.C. Sec. 112, first paragraph for allegedly failing to comply with the enablement requirement.

By this amendment, claim 18 has been cancelled, rendering the rejection moot.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 18.

IV. Discussion of the Rejection of Claim 18 under 35 U.S.C. Sec. 101

Claim 18 has been rejected under 35 U.S.C. Sec. 101 as allegedly improper.

By this amendment, claim 18 has been cancelled, rendering the rejection moot.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 101 rejection of claim 18.

V. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph

Claims 1-18 have been rejected under 35 U.S.C. Sec. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection. Each aspect of the rejection will be discussed separately below.

In the first aspect of the rejection, the Examiner has indicated that the phrase “cyclic hydrocarbon group which may have substituents” is vague. As an initial matter, Applicants note that B is specified in claims 6, 8, 9 and 10.

Applicants submit that the use of this phrase does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. The phrase is defined on page 12, lines 5-21. Substituents of the hydrocarbon group are described on page 12, line 22 – page 14, line 16. Therefore Applicants do not believe that use of this phrase renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the second aspect of the rejection, the Examiner has indicated that “hydrocarbon group”, “heterocyclic” and “acyl” are indefinite in the definition of R¹. As an initial matter, Applicants note that R¹’s definition does not contain the objected to words and phrases in claims 8, 9 and 10.

Applicants submit that the use of these words or phrases does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. The phrase “hydrocarbon group” is defined on page 20, line 25 – page 22, line 18 *inter alia*; “heterocyclic” is defined on page 31, lines 6-10 *inter alia*; and “acyl” is defined on page 31, lines 11-15 *inter alia*. Therefore Applicants do not believe that use of this phrase renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the third aspect of the rejection, the Examiner has indicated that substituents for the amino groups are indefinite in the definition of R². As an initial matter, Applicants note that R²’s definition recites specific amino substituents in claim 9.

Applicants submit that the substituents of amino groups do not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Substituents of amino groups are defined on page 32, line 7 – page 35, line 2 *inter alia*. Therefore Applicants do not believe that the substituents of amino groups renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the fourth aspect of the rejection, the Examiner has indicated that the phrase “divalent group” is indefinite in the definition of D. As an initial matter, Applicants note that D’s definition recites specific divalent groups in claims 9 and 10.

Applicants submit that the objected to phrase does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Divalent groups for D are defined on page 19, line 7 – page 20, line 5 *inter alia*. Therefore Applicants do not believe that the phrase “divalent group” in the definition of D renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the fifth aspect of the rejection, the Examiner has indicated that the definition of E is indefinite for R^a and R^b in the recitation of “hydrocarbon group which may have substituent(s)”. As an initial matter, Applicants note that E is specified in claims 9 and 10.

Applicants submit that the objected to phrase does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. The objected to phrase is defined on page 35, lines 19-22 *inter alia*. Therefore, Applicants do not believe that the phrase “hydrocarbon group which may have substituent(s)” in the definition of E renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the sixth aspect of the rejection, the Examiner has indicated that the phrase “divalent group” is indefinite in the definition of G and L. As an initial matter, Applicants note that L’s definition recites specific divalent groups in claims 6, 9 and 10 and G’s definition recites specific divalent groups in claims 9 and 10.

Applicants submit that the objected to phrase does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Divalent groups for G are defined on page 20, lines 10-12 *inter alia*, and divalent groups for L are defined on page 36, lines 2-4. Therefore, Applicants do not believe that the

phrase “divalent group” in the definition of G and L renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the seventh aspect of the rejection, the Examiner has objected to the term “substituent” recited in the definitions for A, X and Y. As an initial matter, Applicants note that X, Y and A’s definitions recite specific substituents in claim 9; specific substituents are recited for A in claim 8 and specific substituents are recited for X and Y in claim 10.

Applicants submit that the objected to term does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Substituents for A are defined on page 12, line 22 – page 14, line 15 *inter alia*; and for X and Y on page 36, lines 16-18 *inter alia*. Therefore Applicants do not believe that the term “substituent” in the definition of A, X and Y renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the eighth aspect of the rejection, the Examiner has objected to the phrase “R² and an atom on ring B may form a ring” as indefinite. As an initial matter, Applicants note that such a ring is not a possibility in claim 7.

Applicants submit that the objected to phrase does not render independent claims 1, 16 and 17 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Rings which may be formed are defined on page 14, line 23 – page 16, line 2 *inter alia*. Therefore, Applicants do not believe that the objected to phrase renders claims 1, 16 and 17 nor the claims dependent upon claim 1 indefinite.

In the ninth aspect of the rejection, the Examiner has objected to the term “prodrug” in claim 11. Applicants submit that the objected to term does not render claim 11 indefinite, as it is understood by those skilled in the art given the teachings of the specification. Prodrugs are defined on page 71, line 20 – page 73, line 11 *inter alia*.

In the tenth aspect of the rejection, claims 13-16 have been rejected as improper. By this amendment, claims 14 and 15 have been deleted; claim 13 has been amended to recite carriers in accordance with the teachings of the specification at page 78, line 24 – page 80, line 17 *inter alia*; and claim 16 has been re-written as an independent method of treating claim.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

VI. Conclusion

Reconsideration of the claims and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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